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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,299	10/09/2001	Yoshiya Gunji	212289US0PCT	4922

22850 7590 12/16/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/926,299	GUNJI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David J Steadman	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Status of the Application*

- [1] Claims 1-27 are pending in the application.
- [2] Applicants amendment to the specification and claims 8, 11-12, and 14 and addition of claims 26-27 in the amendment filed October 09, 2001, is acknowledged.

### *Lack of Unity*

- [3] Lack of unity is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

**Group I**, claims 1-13 and 26-27, drawn to the special technical feature of a *Methylophilus* bacterium and the first claimed method of use, *i.e.*, a method for producing an L-amino acid.

**Group II**, claims 14-15, drawn to the special technical feature of a method for producing bacterial cells of a *Methylophilus* bacterium with an increased content of an L-amino acid.

**Group III**, claims 16-17, drawn to the special technical feature of a DNA encoding SEQ ID NO:6 including SEQ ID NO:5.

**Group IV**, claims 18-19, drawn to the special technical feature of a DNA encoding SEQ ID NO:8 including SEQ ID NO:7.

**Group V**, claims 20-21, drawn to the special technical feature of a DNA encoding SEQ ID NO:10 including SEQ ID NO:9.

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**Group VI**, claims 22-23, drawn to the special technical feature of a DNA encoding SEQ ID NO:12 including SEQ ID NO:11.

**Group VII**, claims 24-25, drawn to the special technical feature of a DNA encoding SEQ ID NO:14 including SEQ ID NO:13.

**[4]** The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding special technical feature is a contribution over the prior art. The inventions of Groups I-VII do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature of Group I is a *Methylophilus* bacterium, which is shown by Windass et al. (*Nature* 287:396-401; cited as reference AM in the IDS filed January 10, 2002) to lack novelty or inventive step because Windass et al. teach a *Methylophilus* bacterium, which has the ability to produce L-amino acids for synthesis of endogenous proteins and does not make it a contribution over the prior art.

According to PCT Rule 13.2, unity of invention exists only when there is a shared same or corresponding special technical feature among the claimed inventions. The bacterium of Group I does not have unity of invention with the method of Group II as the method of Group II produces bacteria that are not encompassed by the bacterium of Group I, e.g., a wild-type *Methylophilus* bacterium.

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Groups I and III-VII do not have unity of invention as each group has a different special technical feature not shared by the remaining groups. Group I is directed to the special technical feature of a *Methylophilus* bacterium, not shared by any of the remaining groups. Group III is directed to the special technical feature of a DNA encoding SEQ ID NO:6 including SEQ ID NO:5, not shared by any of the remaining groups. Group IV is directed to the special technical feature of a DNA encoding SEQ ID NO:8 including SEQ ID NO:7, not shared by any of the remaining groups. Group V is directed to the special technical feature of a DNA encoding SEQ ID NO:10 including SEQ ID NO:9, not shared by any of the remaining groups. Group VI is directed to the special technical feature of a DNA encoding SEQ ID NO:12 including SEQ ID NO:11, not shared by any of the remaining groups. Group VII is directed to the special technical feature of a DNA encoding SEQ ID NO:14 including SEQ ID NO:13, not shared by any of the remaining groups.

The method of Group II does not have unity of invention with the DNAs of Groups III-VII as the DNAs of Groups III-VII are neither made nor used by the method of Group II.

**[5]** Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**[6]** Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:30 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.  
Patent Examiner  
Art Unit 1652

  
12-10-03  
DAVID STEADMAN  
PATENT EXAMINER